

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Joseph C. Eder and Alejandro Berenstein
Application No.:	10/063315
Filed:	April 10, 2002
For:	Hybrid Stent
Examiner:	Ryan J. Severson
Group Art Unit:	3731

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: S63.2B-10039-US01

REPLY BRIEF

This is a Reply Brief for the above-identified application in response to the Examiner's Answer of June 7, 2010.

A Notice of Appeal was filed in this case on November 30, 2009. An Appeal Brief was filed February 1, 2010. The Commissioner is authorized to charge Deposit Account No. 22-0350 for any other fees which may be due with this Appeal.

Argument

Claims 38-41, 44, 46-49, and 51-55 stand rejected under 35 USC § 103(a) over Imran (US 5,817,126) in view of Vonesh (US 6,336,937) and Hojeibane (US 5,911,732). Claims 43, 45, and 50 stand rejected under 35 USC § 103(a) over Imran in view of Vonesh and Hojeibane in further view of Klein (US 5,593,442).

The rejections set forth in the Examiner's Answer are deficient for at least the following reasons: (1) the rejections mischaracterize the Vonesh reference, and (2) the rejections fail to consider the merits of Applicants' arguments.

(1) The Rejection Mischaracterizes the Vonesh Reference

Page 10, paragraph 6 of the Examiner's Answer states:

However, it appears applicant has simply ignored the rest of the disclosure of Vonesh et al. that Examiner pointed out in the advisory action of 11/9/2009. Namely, Vonesh et al. disclose at column 11, lines 54-59 that the device may likewise includes segments that are self-expanding and segments that are *not* self-expanding. Therefore, the disclosure of Vonesh et al. clearly contradicts appellant's position that the entire stent is self-expanding.

The Examiner further indicates that the rejection did not rely on the inclusion of the sleeve 36 of Vonesh. Page 6 of the Examiner's Answer.

Applicants disagree with the Examiner's characterization of Vonesh. The device of Vonesh achieves its hybrid expansion properties via the combination of its constituent components, i.e., the stent and the graft. The underlying stent of Vonesh is disclosed as being self-expanding. Nowhere is there any disclosure that any portion of the stent is balloon expandable. Thus, Applicants are unable to find, in Vonesh, a stent having the properties asserted by the Examiner (or claimed in the immediate claims).

Vonesh discloses "a device having hybrid expansion properties (i.e., being both self-expanding and balloon-expandable) . . . by combining components having balanced expansion and restrictive properties." Column 8, lines 56-60. *See e.g.*, FIG. 4 of Vonesh, below.

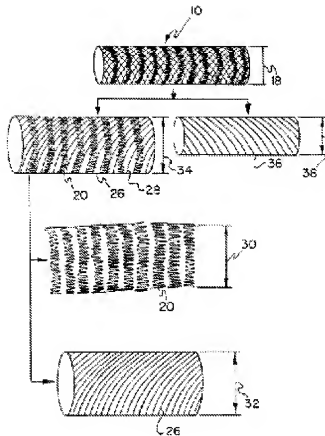


FIG. 4

Moreover, as shown in FIGs. 5-9, Vonesh discloses “various embodiments of a device 10 of the present invention that employ different constructions along the length of the device 10.” Column 11, lines 43-45. Finally, at column 11, lines 54-59, Vonesh states, “[i]t should be further appreciated that these modified devices may likewise include segments that are self-expanding and segments that are not self-expanding, again programmed for particular applications where consistent-graft performance along the length of the graft is not preferred.” The segments being balloon expandable and self-expanding include both the stent and the graft element or sleeve. In contrast to the Examiner’s assertion that Vonesh discloses a stent having segments which are self-expanding and segments that are not self-expanding, the expansion characteristics of the device of Vonesh are determined by the presence or absence of graft element(s) on a particular segment of the stent.

In this regard, Vonesh states, at column 9, lines 57-67:

In order to then cause the device to establish the second dimension 18 previously described with respect to FIG. 2, a distensible sleeve element 36 is employed. This distensible sleeve element 36 may be constructed in the same manner as previously described with respect to the graft element 26. The difference is that the distensible sleeve element 36 is formed to have a first operative dimension 38 approximately corresponding to the second dimension 18. Additionally, the distensible sleeve element 36 has the ability to be deformed beyond its first operative dimension through the application of more than a threshold distensive force therein.

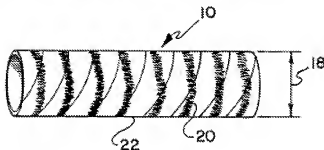


FIG. 2

Therefore, although Vonesh discloses, at column 11, lines 48-50, “devices 10 that include a self-expanding and balloon distensible section 56 and a section 58 that is self-expanding only,” Vonesh does not disclose a stent having the combination of self-expanding and not-self expanding characteristics as claimed in independent claims 38 and 46, respectively. Nothing in Vonesh discloses a stent that, by itself, has different expansion characteristics along its length. Consequently, the Examiner’s reliance on Vonesh is misplaced.

In light of the foregoing language of Vonesh, Applicants again submit that the distensible sleeve element(s) of Vonesh provide the characteristics that the Examiner asserts are present in the stent of Vonesh alone. Consequently, the Examiner’s reliance on Vonesh is misplaced and Applicants request that the Board reverse the Examiner’s rejections.

(2) The Rejection Fails to Consider the Merits of Applicants’ Arguments

In the Appeal Brief, Applicants argued that one of ordinary skill in the art would not be motivated to combine the coil segment of Hojebane with the modified stent/graft of Imran/Vonesh because the proposed combination would render the prior art invention unsuitable

for its intended purpose. *See* MPEP § 2143.01(V). The Examiner's Answer has ignored this argument.

The Examiner states, "even if Examiner had suggested including the sleeve (36) of Vonesh et al. on the Imran stent, the claims would not prevent such a construction because the stent would still have segments that could not expand due to the restraint offered by the sleeve." Examiner's Answer, page 6. However, as noted above, the Examiner asserts that the rejection did not rely on the sleeve of Vonesh as the basis for concluding that Applicants' arguments were unpersuasive. In other words, the Examiner's Answer ignores the arguments presented in Applicants' Appeal Brief – that one of ordinary skill in the art would not combine the coil segment of Hojeibane with the modified stent-graft of Imran/Vonesh – in lieu of articulating why it is believed that these arguments are unpersuasive.

By failing to articulate why Applicants' arguments are believed to be unpersuasive, however, the rejection is deficient. Asserting that the sleeve 36 of Vonesh could be included in the Imran stent necessarily contemplates the combination of elements from Vonesh and Imran. Therefore, reasons tending to dissuade the skilled artisan from making the asserted combination or modification must also be considered. *See e.g.*, MPEP § 2141.02(VI) ("[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.) (emphasis in original) (internal citations omitted)) and MPEP § 2143.01(V) ("[i]f a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984))). However, the Examiner's rejection fails to consider the reasons for not making such a combination, and is therefore not in compliance with the MPEP. In short, in the instance that the sleeve element 36 of Vonesh is relied on, the Examiner must also take into consideration any bases for not making the asserted combination or modification. The rejection has failed to do so. Consequently, and for this additional reason, Applicants request that the Board reverse the Examiner's rejection.

For at least the foregoing reasons, the Examiner's characterization of the Vonesh reference is erroneous. The combination of Imran, Vonesh, and Hojeibane does render obvious a stent as claimed. Moreover, the Examiner has failed to comply with the requirements of the

MPEP. Consequently, Applicants request that the Board reverse the Examiner's rejections of claims 38-41 and 43-55.

Respectfully submitted,

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